

REMARKS

Claims 32-52 remain in this application. Claims 2-11 and 22-31 have been cancelled without prejudice to their subsequent reinstatement. Claims 32-52 have been added. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

Specification

The specification has been objected to due to various informalities. Applicants submit that the specification has been amended to correct the noted informalities.

Claim Objections

The Examiner has objected to claim 10. Claim 10 has been cancelled. Therefore, the objection is moot.

35 U.S.C. §103(a) Rejection - Armani in view of Chan

The Examiner has rejected former claims 2-11 and 22-31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2004/0179573 issued to Armani et al. (hereinafter “Armani”) and further in view of U.S. Patent No. 6,236,060 issued to Chan et al. (hereinafter “Chan”). These claims have been cancelled. The Applicants respectfully submit that the present claims are allowable over Armani and Chan.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that Armani and Chan should not be combined. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Armani and Chan. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Examiner has stated that Armani does not “*explicitly teach that the microresonator comprises silicon dioxide with silicon or silicon germanium nanocrystals*” (paragraph 9 on page 3 of present Office Action). Further, Chan does not teach or even suggest that the nanocrystals disclosed therein may be used in a microresonator. Accordingly, there is no suggestion to use silicon or silicon germanium nanocrystals in a microresonator.

The Examiner has stated that the motivation to combine the references is in order to result in a “high efficiency electroluminescent structure”. However, this motivation falls short of any suggestion to use silicon or silicon germanium nanocrystals in a microresonator.

As the courts have instructed, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless

the prior art suggested the desirability of the modification. Further, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

For the foregoing reasons, Applicants submit that the Examiner has failed to establish a prima facie case of obviousness set forth in MPEP Section 706.02(j). Specifically, the Examiner has failed to show that “[t]he teaching or suggestion to make the claimed combination ... [is] found in the prior art, and not based on Applicant’s disclosure”, as required by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For at least these reasons, claims 32 and 45, as well as their dependent claims, are believed to be allowable over Armani and Chan.

Conclusion

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

Request For Telephone Interview

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

Request For An Extension Of Time

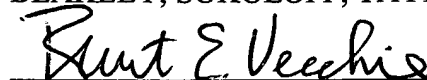
The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Charge Our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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